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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

MEDLEY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/779,588

Applicant(s)

LEVY

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE Three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 57-68 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 57-68 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed subject matter "A coating formed on the surface ... lubricant" of claim 57 (and its dependent claims) is not properly described in the application as filed and consequently raise doubt as to applicant's possession of the claimed invention at the time of filing on the instant application. After a careful review of the instant application disclosure and examples, the examiner have found that applicants' disclosure is to "a method of lubricating a surface comprising coating the surfaces with a lubricant composition", note the second paragraph found on page 20 of the instant application. Applicant have made numerous disclosure to lubricant compositions, note paragraph 3 of page 29, but there is no specific reference to "a coating formed on the surface of a substrate". Applicants discloses that the lubricant composition can be shaped by any conventional molding or extruding process to form discs, sheets, rods, blocks, powders, or filaments, and especially solid lubricant compositions that can be formed to the contours of the surface or surfaces that are being lubricated, note the first full paragraph on page 30. Applicants' examples of the said lubricant compositions or devices for use as solid and/or liquid lubricants can include washers, friction reducing plates, pads, composites,

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agglomerates, bearings, shock absorbers/struts/pressure pad/impact plates, shims and spacers; seals; and gels or greases, note pages 37-38. The examiner did not find any explicit disclosure for claim 61 "the substrate comprises a cable", for "claim 62 the substrate comprises a wire" nor for "claim 58 the superabsorbent polymer absorbs greater than 100 times its weight in water and desorbs water when the coating is dried". The disclosure bridging pages 22-23 discloses that the superabsorbent polymer employed according to the instant claimed invention, absorbs from about 25 to greater than 100 times its weight in water and comprises a polymer of acrylic acid, an acrylic ester, acrylonitrile or acrylamide, including copolymers thereof or starch graft polymers thereof, or mixtures, wherein the mixtures contain from 2 to about 3 or 4 superabsorbent polymers. Applicant is invited to point out to the examiner the locations of the said subject matters in the instant application.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention as of its filing date. In re Glass, 429 F.2d 1228, 181 USPQ 31 (CCPA 1974).

Applicants attention is directed to the various sections of the MPEP:

- | | |
|------------|-----------------------------------|
| 608.01 (p) | Completeness (R-1), |
| 702.01 | Obviously Informal Case, |
| 201.07 | Continuation Application, and |
| 201.08 | Continuation-in-Part Application. |

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Claims 57-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claimed subject matter "A coating formed on the surface ... lubricant" of claims 57 (and its dependent claims); "the superabsorbent polymer absorbs greater than 100 times its weight in water and desorbs water when the coating is dried" of claim 58; "the substrate comprises a cable" of claim 61, and "the substrate comprises a wire" of claim 62 are not enabled by the specification and raise doubt of enablement. The said claimed limitations were not described in the instant application disclosures and examples for the reasons discussed in the above rejection.

In view of the rejection of the claims as failing to define the invention in the manner required by 35 U.S.C. 112, no search by the examiner have been made.

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

Medley/nt

7/19/01

Margaret B. Medley
MARGARET MEDLEY
PRIMARY EXAMINER